

Application No. 10/656,865
Amendment dated February 22, 2005
In Reply to Office Action dated September 20, 2004

Remarks

Claims 1-19 are pending.

Claims 1-19 stand rejected.

Claims 1-10 have been cancelled without prejudice.

Claims 11-19 have been amended.

Claims 11-19 are submitted herein for review.

No new matter has been added.

In the Office Action, the Examiner has noted that no claim 4 was filed originally, and the claims have been renumbered from 1-20 to 1-19. Applicant has amended the claim numbers and claim dependencies accordingly.

In the next section of the Office Action, the Examiner has objected to the drawings under 37 CFR 1.83(a) for failing to show all of the elements specified in the claims. In particular, the Examiner objected to the fact that figures did not show the images on folding panels and pages as indicated in claims 5-13 and 17-19.

Applicant has amended Figures 1A through 1G to include images of a face and eyes according to the written description in the specification and claims as originally filed. In the Figures, the image of a face was added to pages 4 and 6 in Figure 1A. The image of the face on sheet 6 shows a first type of makeup on the eyes. The image of the face on sheet 4 shows a second type of makeup on the eyes as contained on the panel insert 8, in particular the image on the back of panel 16 (which is in top when insert 8 is completely folded).

Figures 1B through 1G show various eye makeup arrangements which, when folded properly according to Figures 1C through 1G, show different eye makeup arrangements in place overtop of the face images on sheets 4 and 6 from Figure 1A.

These amendments to Figures 1A through 1G do not constitute new matter. All of the added material is found in the original specification and claims as filed and thus supports the images of a face with varying eye makeup arrangements.

The specification on page 6, line 1 to page 8, line 1 gives the general description of pages 4 and 6, panel insert 8 and various panels 10, 12, 14, 16, 18 and 20 and how they fold with respect to one another. Further to this, the description on page 11, line 16 to line 4 states:

“As described above, it is contemplated that in the various configuration of the multi-panel advertising display may contain various prints on the panels that mesh into the print that is placed on the insert below the panels, so that when viewed by a person they could see the full image or content of the advertisement when the panels are folded on top of each other. Panels, when folded out, can convey more information or extend the content on the insert. For example, the image on the insert can be of a woman’s face, placed over her eyes is a multi-panel display. When the display is completely folded the image of the full face can be viewed, because the panel that is functioning as a cover to all the others has the image of the woman’s eyes and other features covered by the multi-panel display are revealed. In another embodiment the multi-panel display can mesh into the image at every stage of folding, each panel can contain an image that will mesh into the image on the insert.” (emphasis added)

From this description, it is clear that the amendments to Figures 1A through 1G are in fact supported by the specification as filed, and thus do not constitute new matter.

Further in support of the amended Figures 1A through 1G, the specification goes on in page 12, lines 10-20 states:

“For example, using advertising display 8 from Figs. 1A-1G as examples,

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left page 4 and right page 6 of magazine 2 each maintain images of a woman's face, having a particular makeup design for their eyes. When the page is initially opened the woman on right page 6 is viewed having the first set of eyes printed on the page itself, whereas the woman on left page 4, whose face is printed on page 4, is viewed with the set of eyes printed on the back side of third panel 16, which is on top when advertise display 8 is closed.

Upon unfolding the various sets of eyes for the woman on pages 4 and 6 of the magazine 2 are viewed with varying sets of eyes, printed on the alternating front and back sides of the panels of advertising display 8, so that an entire series of eye makeup may be viewed using the same head shot of the model. As display 8 is unfolded to the left and right the different panels line up with the images printed directly on pages 4 and 6." (emphasis added)

As such, Applicant respectfully submits that the amending of Figures 1A through 1G to include the image of face with eyes having varied make-up arrangements does not constitute new matter.

In the next section of the Office Action, claim objections were raised to claims 7, 12, 13, and 19 due to minor informalities in the claim language. Applicant has amended claims 12, 13 and 19 accordingly, and cancelled claim 7, and respectfully request that the objection be withdrawn.

In the next section of the Office Action, the Examiner has rejected claims 1, 2 and 4-7 under 35 U.S.C. § 102(b) as being anticipated by Isaac (U.S. Patent No. 3,520,560). Claims 1-4 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Brown (U.S. Patent No. 6,629,800). Claims 1-4 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wilen (U.S. Patent No. 6,752,427). Claims 5-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable by Long (U.S. Patent No. 6,572,149). Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tighe et al. (U.S. Patent No. 5,169,060).

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Applicant has cancelled claims 1-10 and respectfully requests that these rejections be withdrawn. Applicant specifically reserves the right to prosecute these claims in a timely filed continuation application.

In the next portion of the Office Action, the Examiner has allowed claims 11-19. Applicant has amended the claims to correct minor errors and to correct numbering and dependency as noted above. These changes do not affect the scope of the claims.

In view of the forgoing, Applicants respectfully submit that pending claims 11-19 are now in condition for allowance, the earliest possible notice of which is earnestly solicited. If the Examiner feels that an interview would facilitate the prosecution of this Application he is invited to contact the undersigned at the number listed below.

Respectfully submitted,

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APPENDIX 1

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Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 1A-1G. Sheet 1, which includes Figures 1A and 1B, replaces the original sheet 1 including Figures 1A and 1B. In Figures 1A and 1B, the image of a face with eyes having various make-up arrangements has been added. This addition has been added to meet the requirements of 37 CFR1.83(a) and does not constitute new matter as the images of the face and eyes is completely supported by the specification and claims as filed, and is discussed in more detail below.

Sheet 2, which includes Figures 1C through 1G, replaces the original sheet 2 including Figures 1C through 1G. In Figures 1C through 1G, the image of a face with eyes having various make-up arrangement has been added. This addition has been added to meet the requirements of 37 CFR1.83(a) and does not constitute new matter as the images of the face and eyes is completely supported by the specification and claims as filed as discussed in more detail below.

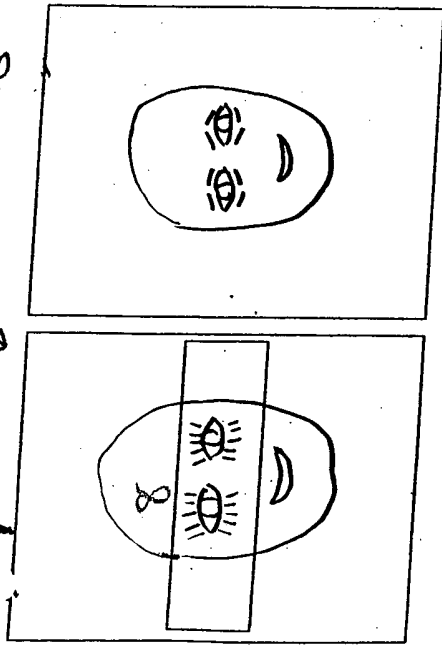
Attachment: Replacement Sheets
Annotated Sheets Showing Changes

Fig 1A

2

4

6



20 Fig 1B

18

16

10

21

14

